

REMARKS

Status of the Claims.

Claims 1-86 are pending with entry of this amendment, no claims being cancelled and no claims being added herein. Claim 39 is amended herein. This amendment simply eliminated the reference to claim 35 incorporating the formula referenced therein.

Restriction.

In the October 30, 2002 Office Action the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

- Group I: Claims 1-18, drawn to a method of modulating activity of a melanocortin receptor;
- Group II: Claims 19-31, drawn to a library for screening for modulators of a melanocortin receptor;
- Group III: Claims 32-38, and 45-598, drawn to a method of prescreening and screening for a modulator of a melanocortin receptor;
- Group IV: Claims 39-44, 66-67, and 70, drawn to a polypeptide;
- Group V: Claims 60-64, drawn to a machine-readable data storage medium;
- Group VI: Claim 65, drawn to an NMR structure;
- Group VII: Claims 71-83, drawn to a non-peptide melanocortin receptor ligand and its pharmaceutical preparation; and
- Group VIII: Claims 84-86, drawn to a method for modulating a melanocortin receptor-mediated physiological process.

In response to this restriction requirement, Applicants provisionally elect Group IV, claims 39-44, 66-67, and 70, with traverse.

Upon election of any one of Groups I-VIII, the Examiner required an election of species as follows:

Species A: a specific polypeptide structure; and

Species B: a specific non-peptide structure.

In response, Applicants elect Species A, a specific polypeptide corresponding to MARP-33 (SEQ ID NO:3).

Applicants note that this is an election of species and not a restriction. Applicants further recognize that, per MPEP §809.02(c), to the extent all species fall within the limitations of a generic claim ultimately determined to be patentable, the non-elected species will no longer be deemed to be withdrawn and claims to the additional non-elected species will be considered by the Examiner.

With respect to the listing of claims readable on the elected species, Applicants note that claims 39, 66 are and 70 are generic and claims 39-44 and 66-67, and 70 are readable on the elected species.

Applicants submit that restriction between Groups I, and IV is unnecessary. According to MPEP §803, the Examiner should examine all claims in an application, even though they are directed to distinct inventions, unless to do so would create a serious burden. In the instant case, the claims of Group IV are directed to polypeptides and pharmaceutical formulations thereof, while the claims of Group I are directed to a method of modulating activity of a melanocortin receptor using peptides having the same formula. A search for art relevant to the peptides is expected to identify prior art, if it exists, relevant to the use of these peptides. Thus, a search for art relevant to Groups I and IV, entails no greater burden than a search for art relevant to Group I alone. Accordingly, Examination of Groups I and IV together entails no serious burden and the restriction between these groups should be withdrawn.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 337-7871.

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Respectfully submitted,


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